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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,773	07/31/2003	Takayuki Yogo	056208.52613US	8467
23911	7590	11/24/2004	EXAMINER	
CROWELL & MORING LLP INTELLECTUAL PROPERTY GROUP P.O. BOX 14300 WASHINGTON, DC 20044-4300			WILLIAMS, ALEXANDER O	
			ART UNIT	PAPER NUMBER
			2826	

DATE MAILED: 11/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/630,773

Applicant(s)

YOGO ET AL.

Examiner

Alexander O Williams

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 3-5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 6-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 7/31/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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Serial Number: 10/630773 Attorney's Docket #: 740819-982
Filing Date: 7/31/2003; claimed foreign priority to 8/1/2002

Applicant: Yogo et al.

Examiner: Alexander Williams

Applicant's election of species of figure 6 (claims 1, 2 and 6-17), filed 9/9/04, has been acknowledged.

This application contains claims 3 to 5 drawn to an invention non-elected without traverse.

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed structure in claims 1, 2 and 6-17 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is

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being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claims 1, 2 and 6-17 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1, 2 and 6, it is unclear and confusing to what is meant by "An electronic device storing and protecting in a case member an insulating substrate and an electronic substrate having an electronic circuit composed of mounted parts, including **at least one** of conductors, **resistors**, and capacitors formed in a film form on said insulating substrate, wherein: **said conductors** formed on said surface of said insulating substrate, excluding a probing portion for electrically connecting with said conductors in a manufacturing process of said electronic device and a mounting portion for connection of said conductors with said mounted parts, are overcoated with one of glass and resin." The claim claims at least one. If a resistor is included and the conductor is not, how does the claim language of the conductor still exist? For example, the elected species was

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figure 6 in which a resistor, not a conductor, is claimed. Where is this structure shown in the drawings?

Any of claims 1, 2 and 6-17 not specifically addressed above are rejected as being dependent on one or more of the claims which have been specifically objected to above.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 2 and 6-17, **insofar as they can be understood**, are rejected under 35 U.S.C. § 103(a) as being unpatentable over Eldridge et al. (U.S. Patent Application Publication # 2002/0132501 A1) in view of Zenhausern et al. (U.S. Patent Application Publication # 2004/0011650 A1).

As to claims 1, similar claims 2 and 6, Eldridge et al. (figures 1 to 18b) specifically figures 13 and 17 show an electronic device storing and protecting in a case member **2112** an insulating substrate **2104** and an electronic substrate

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2141 having an electronic circuit composed of mounted parts **21-6a-2106d,21-2a-2102d** , including at least one of conductors, resistors, and capacitors formed in a film form on said insulating substrate, wherein: said conductors **2142** formed on said surface of said insulating substrate, excluding a probing portion for electrically connecting with said conductors in a manufacturing process of said electronic device and a mounting portion for connection of said conductors with said mounted parts, are overcoated with one of glass and resin; but fail to explicitly show the openings of said probing portion and said mounting portion which are not overcoated are all formed in a shape having no corners at an angle which is less than or equal to 90°; said openings have a shape selected from the group consisting of circular, elliptical, a tetragon having rounded corners and a tetragon having; and said openings surrounded by said overcoating materials are covered with solder or metallic paste.

Briscoe et al. Is cited for showing a multilayered device. Specifically, Briscoe et al. (figures 1-31C) specifically figure 3A discloses show the openings of said probing portion **156,172,180,166,186** and said mounting portion which are not overcoated are all formed in a shape having no corners at an angle which is less than or equal to 90°; said openings have a shape selected from the group consisting of **circular**, elliptical, a tetragon having rounded corners and a tetragon having for the purpose of testing the circuit device.

Therefore, it would have been obvious to one of ordinary skill in the art to use Briscoe et al.'s probing portion to modify Eldridge et al.'s test probing for the purpose of testing the circuit device.

The listed references are cited as of interest to this application, but not applied at this time.

Field of Search	Date
U.S. Class and subclass: 257/48,620,686,685,723,777,528,532	11/18/04

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Other Documentation: foreign patents and literature in 257/48,620,686,685,723,777,528,532	11/18/04
Electronic data base(s): U.S. Patents EAST	11/18/04

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander O Williams whose telephone number is (571) 272 1924. The examiner can normally be reached on M-F 6:30-7:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on (571) 272 1915. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Alexander O Williams
Primary Examiner
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AOW
11/18/04